

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of (first named inventor):	Atty. Docket No.: 007287.00036
<b>Dan Kikinis</b>	
Serial No.: 09/875,460	Group Art Unit: 2421
Filed: June 5, 2001	Examiner: Salce, Jason P.
For: Remote Control of Program Scheduling	Confirmation No.: 6281

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Box AF**

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the final Office Action dated July 16, 2009 ("Final Office Action"), Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The Office erred in asserting that there is a lack of support in the specification for the claims in its rejection of claims 1-3, 6-11, 14-16 and 27-30 under 35 U.S.C. § 112, first

paragraph. In particular, the Office rejects independent claims 1 and 9 at p. 3 for failing to find support in the specification for the feature, “wherein the EPG includes an indication of which web-enabled cellular phone buttons are appropriate for the EPG.” While there is no *in haec verba* requirement, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. *See MPEP § 2163*. An examiner should look to the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention. *Id.* Thus, taking the specification as a whole, Applicant has met the written description requirement of 35 U.S.C. § 112, first paragraph.

- By way of example, the Response dated May 1, 2009, amended the specification to include material previously incorporated by reference from patent application 09/488,361, which is now U.S. Patent No. 6,421,067 (“the ‘067 Patent”). Applicants refer to the specification, as amended, (“Specification”), for the cited support. The incorporated material describes an electronic programming guide (EPG) that includes features to enhance user friendliness. Specification, para. [0030]. The Office correctly notes that the ‘067 Patent discloses an EPG that indicates which buttons on a remote control device are appropriate for performing functions for the EPG. The Office takes the position that the ‘067 Patent fails to teach that a web-enabled cellular phone is used as a remote control device and that it also fails to teach that the remote control unit contains a display screen for displaying an EPG. This support, however, can be found in the Specification. For example, the Specification provides support for a web-enabled cellular phone having the functions of a remote control device. Particularly, the Specification at paragraph [0036] provides that “[a] wireless hand held device, such as hand held unit 220 [of Fig. 2] allows for a great deal of flexibility. A user may move about the room which contains video display 105 [of Fig. 2] and be able to control the functions of the EPG from any point. When using a wireless hand held device to control the EPG, the device may also assume the functions of the remote control device.” (Emphasis added.) Further, the Specification at paragraph [0035] provides that “[h]and held unit 220 [of Fig. 2], could, for example, be a personal digital assistant (PDA).” In addition to further disclosure of the Specification, one skilled in the art will appreciate that hand held unit

220 of Fig. 2 could be web-enabled phone and that such devices can contain a display screen large enough to allow for an EPG to be displayed therein. *See also Id.* at paras. [0039]-[0040] and para. [0006]. Thus, Applicant's specification provides support for the claimed subject matter and the rejection should be withdrawn.

- The Office erred in its combination of Ellis et al. (U.S. Patent Publication No. 2005/0028208, "Ellis Publication") in view of Ellis et al. (U.S. Patent No. 6,774,926, "Ellis Patent") in further view of Yoshida (U.S. Patent No. 5,936,611, "Yoshida") in rejecting claims 1-3, 6, 9-11, 14, 28 and 30. Claims 1 and 9 both generally relate to displaying an EPG on a web-enabled cellular phone, indicating which buttons on the web-enabled phone buttons are appropriate for performing functions for the EPG, receiving selections entered over the Internet via the web-enabled cellular phone, storing the EPG selections on a storage device, and transmitting the EPG selections to be displayed on a television when requested. In the Final Office Action, the Office correctly notes at p. 6 that neither the Ellis Publication nor the Ellis Patent teach or suggest, either separately or in combination, indicating which buttons on the web-enabled cellular phone buttons are appropriate for performing functions for the EPG. Instead, the Office relies on Yoshida as describing this function. Yoshida, however, merely describes displaying descriptions of what a remote control key does for a user. *See* Yoshida, col. 4, lines 52-64. As previously discussed in Applicant's Response dated May 1, 2009, Yoshida does not teach or suggest "indicating which buttons on the web-enabled cellular phone are appropriate for performing functions for the EPG" (emphasis added). Yoshida describes a user help function that will provide a functional description of what a remote control key does. *See* Yoshida, col. 6, line 30 – col. 8, line 29. This is reinforced in Figs. 7 and 8, where Yoshida describes providing information on the function of a specific key, as requested by a user. In contrast, claim 1 recites indicating what keys can be used to perform functions. Providing such an indication may be helpful to a user for avoiding confusion about what buttons are available especially if a web-enabled phone is not primarily designed for EPG control. While Yoshida describes providing information about the function of a user identified key, Yoshida fails to teach or suggest indicating which buttons are appropriate for performing functions for the EPG. That is, in Yoshida,

a user first identifies the key and subsequently receives functionality information about the key. Claim 1, in contrast, recites indicating the buttons for functions that are to be performed for the EPG.

- Claims 2-3, 6-8, 10-11, 14-16 and 27-30 are dependent claims and are thus allowable for at least the same reasons as their respective base claims.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the rejections of other claims not identified above are also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.

### CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3156.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated November 16, 2009

By: /Chunhsi Andy Mu/  
Chunhsi Andy Mu  
Registration No. 58,216  
1100 13<sup>th</sup> Street, N.W.  
Washington, D.C. 20005  
Tel: (202) 824-3000  
Fax: (202) 824-3001